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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/265,183 03/09/99 TOMIOKA

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EXAMINER

MM91/0808

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QUASH, A

ART UNIT

PAPER NUMBER

2881

DATE MAILED:

08/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/265,183

Applicant(s)

TOMIOKA, MASA HARU

Examiner

Anthony Quash

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: ____.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Pertaining to claim 4, it has held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Pertaining to claim 17, the functional recitation that "... said optical element comprises an optical element for a Nomarski observation of transmitted light." Has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth 35 U.S.C. 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. In re Fuller, 1929 C.D. 172; 388 O.G. 279.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stock [287], G. J. Brakenhoff et al; "Femtosecond Pulse Width Control in Microscopy by Two-Photon Absorption Autocorrelation" and Denk [613]. As per claims 1,14, Stock [287] teaches a laser beam source for emitting a pulse laser beam for exciting a sample to cause a fluorescent light by multi-photon excitation phenomenon, a detector for detecting fluorescent light, an optical system for forming an optical path of said pulse laser beam for guiding said pulse laser beam. It also teaches a pre-chirp compensator arranged on said optical path for preventing a pulse width of said pulse laser beam from widening and a plurality of objective lenses capable of being selectively arranged on said optical path for collecting the pulse laser beam on the sample. See Stock [287] abstract, fig. 1, and columns 3,6 & 7. However it does not teach providing a station for placing a sample to be observed. G. J. Brakenhoff does teach providing a station for placing a sample to be observed, and a correcting mechanism including optical correcting means for correcting an optical path length of said optical path to cause the pulse width of said pulse laser beam to be constant. See G. J. Brakenhoff p. 255 column 1, p. 257 column 2, and p. 258 column 1. Denk [613] also teaches a laser scanning microscope, a fluorophore having appropriate emission, a detector, and a station for placing the sample. See Denk [613] columns 9-10. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a station for placing a sample to be observed, and a correcting mechanism including optical correcting means for correcting an optical path length of said optical

path to cause the pulse width of said pulse laser beam to be constant in order to provide interactive control of the pulse width at the focal point.

As per claims 2,15, Stock [287] teaches an interlocking mechanism for causing the correcting mechanism to be interlocked with said objective lenses. It also teaches microscope being comprised of a plurality of objective lenses. See Stock [287] column 3. Also see G. J. Brakenhoff p. 253 column 2.

As per claims 3,4, Stock [287] teaches the optical correcting means arranged on said optical path in a position where said pulse laser beam forms a parallel luminous flux. Stock [287] also teaches optical correcting means including a plurality of optical correcting elements capable of being arranged selectively on said optical path to cause the optical path length of said optical path to be constant in accordance with the respective optical path lengths of said objective lenses. See Stock [287] columns 3 & 4. Also see G. J. Brakenhoff p. 258 column 2.

Claims 5,6,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stock [287] and G. J. Brakenhoff as applied to claim 4 above. Stock [287] and G. J. Brakenhoff teach all aspects of the claims except for the correcting mechanism including a rotor and a slide supporting said optical correcting elements. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a rotor and a slide to support optical correcting elements since it was known in the art of microscopes to do so. Also see Ichic [342] fig. 2. It also would have been obvious to one of ordinary skill in the art at the time of the invention to have the correcting elements and said objective lenses be supported by the same supporting member and

moved together in order to ensure that the proper distance between the correcting element and the objective lenses are maintained at all times which will then aid in the focusing of the device.

As per claims 8,9, Stock [287] and G. J. Brakenhoff teach all aspects of the claimed invention except for explicitly stating that the optical correcting element is adjustable by applying different voltages or pressures to the cause the optical path length of the optical path to be constant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use different voltages or pressures to cause the optical path to be constant since it is well known in the art to use different voltages and pressures to move or adjust optical correcting units.

As per claim 10, Denk [613] teaches the optical system further comprising a scanning mechanism. See Denk [613] column 11.

As per claim 11, it would have been obvious to one of ordinary skill in the art at the time of the invention to position the optical correcting means between the scanning unit and the pre-chirp compensator in order correct the beam before it reaches the compensator so that t

As per claim 12, Denk [613] teaches the optical system including a portion for forming an optical path for guiding said fluorescent light to said detector. See Denk [613] column 5,10 and figs. 1,1A.

As per claim 16, G. J. Brakenhoff teaches an objective lens being arranged on the said optical path for collecting the pulse laser beam on the sample and an optical element inserted between said pre-chirp compensator and said objective lens. See G.

J. Brakenhoff p. 254 fig. 2. However, it does not explicitly state that there should be a plurality of objective lenses capable of being selectively arranged on said optical path nor does it state that the optical element should be flat. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a plurality of objective lenses capable of being selectively arranged on said optical path in order to allow one to change the objective lens so without disturbing the rest of the apparatus in order to better focus the beam. It also would have been obvious to one of ordinary skill in the art at the time the invention was made to make the optical element flat since discovering the optimum shape would only involve routine skill in the art.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stock [287], G. J. Brakenhoff and Denk [613] as applied to claim 1 above, and further in view of White [289]. Stock [287], G. J. Brakenhoff and Denk [613] teach all aspects of the claimed invention except for the laser beam being detected that has already been transmitted through the sample. However, White [289] does teach a laser beam being detected after transmission of the beam. See White [289] abstract, fig. 1, and column 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to position a detector after the specimen in order to determine the amount of light that passes through the specimen as taught in White [289].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ichie U.S. Patent 5,583,342.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Quash whose telephone number is (703)-308-6555. The examiner can normally be reached on M-F from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Arroyo, can be reached on (703)-308-7722. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0956.



A. Quash 8/3/01



BRUCE ANDERSON
PRIMARY EXAMINER